

REMARKS/ARGUMENTS

The Examiner is requiring restriction to one of the following groups:

Group I: Claims 1-11 and 17-20, drawn to an elastomer film; and

Group II: Claims 12-16, drawn to a method of producing an elastomer film.

Applicants elect, with traverse, Group I, Claims 1-7, 11, & 17-20, for examination.

Applicants note Claims 8-10 were canceled in the Article 34 claims.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Office if restriction is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Office has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), *i.e.* why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described.

The Office alleges that the claims of Groups I and II lack unity of invention because, under PCT Rule 13.2, the groups lack the same or corresponding special technical features for the following reasons: "The special technical feature of the main invention -coating said mixed liquid on a substrate- is not shared with the subordinate invention."

However, Annex B of the Administrative Instructions under the PCT, paragraph b (Technical Relationship), states (with emphasis added):

The expression "special technical feature" is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, ***considered as a whole***, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

Applicants respectfully submit that the Office did not consider the contribution of the invention ***as a whole*** in alleging a lack of unity of invention. Furthermore, Applicants respectfully submit

that the Office has not provided any indication that the contents of the claims were interpreted in light of the description in making the assertion of a lack of unity. Thus, the Office has not met the burden necessary to support the assertion nor the burden necessary to support the assertion of a lack of unity of the invention.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

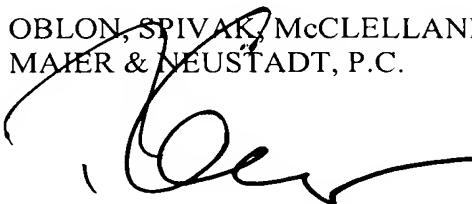
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Respectfully Submitted,

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